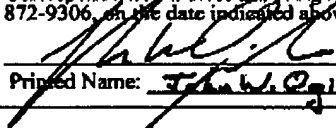


JUN 27 2005

PATENT APPLICATION
ATTORNEY DOCKET NO. 3003.2.9A

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

| | |
|--|--|
| <p>ART UNIT: 2155</p> <p>EXAMINER: Thu Ha Nguyen</p> <p>APPLICANT: Sanchaita Datta and Ragula Bhaskar</p> <p>SERIAL NO.: 10/034,197</p> <p>FILED: December 28, 2001</p> <p>FOR: COMBINING CONNECTIONS FOR PARALLEL ACCESS TO MULTIPLE FRAME RELAY AND OTHER PRIVATE NETWORKS</p> | <p>APPELLANTS' REPLY</p> <div style="border: 1px solid black; padding: 5px;"><p>CERTIFICATE OF FAX TRANSMISSION</p><p>DATE OF TRANSMISSION: <u>27 June 2005</u></p><p>I hereby certify that this paper and a Change of Correspondence Address are being faxed to 703-872-9306, on the date indicated above.</p><p> Printed Name: <u>John W. Ogline</u></p></div> |
|--|--|

Commissioner:

On August 17, 2004, Appellants filed an Original Appeal Brief appealing from a Final Office Action mailed April 19, 2004. On December 23, 2004, the Examiner reopened prosecution by mailing a Reopening Office Action. On March 4, 2004 Appellants filed a Supplemental Appeal Brief, and on June 17, 2005 the Examiner's Answer was mailed. The present paper is in Reply to the Examiner's Answer.

This application has been granted *accelerated* examination status.

Grouping of Claims

The grouping of claims for the appeal is unsettled.

The Examiner's Answer states one grouping of claims on page 2, asserts on that page that this claim grouping was recited in Appellants' brief, and then repeats the grounds for rejection that were stated in the Reopening Office Action. However, the grouping of claims stated on page 2 of the Examiner's Answer was not recited in Appellants' brief, and it does not follow the structure of the rejections stated in the Reopening Office Action.

Page 2 of the Examiner's Answer identifies three claim groups:

Claims 1, 2-12;
Claims 13, 14-18; and
Claims 19, 20-21.

But these three groups are not consistent with Appellants' Brief or with the stated grounds for rejection. This claim grouping (three groups: 1-12, 13-18, 19-21) given in the Answer is not accepted by Appellants.

Page 4 of the Supplemental Appeal Brief identified seven claim groups:

Group I: claims 9, 15
Group II: claims 1-3, 8, 10-12, 14, 18, and 20
Group III: claims 4, 13, 16, and 21
Group IV: claim 5
Group V: claim 17
Group VI: claims 6 and 7
Group VII: claim 19

This grouping generally tracks the Reopening Office Action grounds, by grouping claims that are rejected on the same grounds and for which there is also clearly a discussion of all cited references. This approach is explained in the Supplemental Appeal Brief on pages 3 and 4, in the presentation of issues and claim groupings. However, this approach could be seen as departing from the rejections' structure by separating claims 9 and 15 into their own group.

Arrival at an appropriate claim grouping is further complicated by the fact that the Examiner's Answer is not internally consistent. On page 2, the Answer identifies three claim groupings, but on pages 3-17 it repeats rejections (made in the Reopening Office Action) that use more than three groupings.

In short, without further action, the Board will face multiple inconsistent claim groupings. This could hamper a full, efficient, and fair review of the claims. In the interest of promoting such review, and in a spirit of compromise with the Examiner, Appellants hereby agree to modify the claim grouping of their Supplemental Appeal Brief by treating claim 9 as standing or falling with its parent claim 1, and by treating claim 15 as standing or falling with its parent claim 13. The resulting claim grouping follows the structure of the rejections and reduces the number of claim groups by one.

Pursuant to M.P.E.P. § 1206, Appellants therefore submit the six (not seven) claim groups shown below. Please refer to the Reopening Office Action and the two Appeal Briefs for identification and discussion of the specific claim limitations involved. Within each of these six groups, the claims stand or fall together.

| (Group) claims | References cited | Sample reasons for patentability |
|--|-----------------------------------|---|
| (II) claims 1-3, 8, 9, 10-12, 14, 18, and 20 | Kitai + Albright | Kitai + Albright combination is not supported; see Supp. Appeal Brief at 6-7, Orig. Appeal Brief at 13-14: no motive to combine frame relay reference Albright w/ LAN reference Kitai; no motive to combine serial reference Albright w/ parallel reference Kitai |
| (III) claims 4, 13, 15, 16, and 21 | Kitai + Albright + Pearce | Kitai + Albright combination is not supported per Group II arguments; no evidence showing motive to add Pearce, see Orig. Appeal Brief at 10-11 |
| (IV) claim 5 | Kitai + Albright + Dutta | Kitai + Albright combination is not supported per Group II arguments; no evidence showing motive to add Dutta, see Orig. Appeal Brief at 11-12 |
| (V) claim 17 | Kitai + Albright + Pearce + Dutta | Kitai + Albright combination is not supported per Group II arguments; no evidence showing motive to add Pearce, see Orig. Appeal Brief at 10-11; no evidence showing motive to add Dutta, see Orig. Appeal Brief at 11-12 |
| (VI) claims 6 and 7 | Kitai + Albright + Goldszmidt | Kitai + Albright combination is not supported per Group II arguments; no evidence showing motive to add Goldszmidt, see Orig. Appeal Brief at 12-13 |
| (VII) claim 19 | Kitai + Pearce + Goldszmidt | Kitai + Pearce combination is not supported, see Orig. Appeal Brief at 10-11; Kitai + Goldszmidt combination is not supported, see Orig. Appeal Brief at 12-13 |

Reply to Examiner's Responses

On pages 17-24, the Examiner's Answer responds to arguments made by Appellants. In reply, Appellants respectfully submit that the claims are patentable and the rejections are flawed.

Examiner's response (A) seeks to reverse the Examiner's position by arguing that local area networks as disclosed in Kitai are actually "private networks" as claimed. The only basis given for this reversal in the Answer is that "the examiner reopened the Office action with new ground of rejection." This is not a sufficient basis to support the change in position. Indeed, the Reopening Office Action admits in its discussion of claim 1 that "Kitai does not explicitly teach at least two private network interfaces" and it then relies on Albright to teach private network interfaces. As explained at length in both the Original Appeal Brief at pages 5-9 and the Supplemental Appeal Brief at pages 5-6, Kitai does not teach private networks. This lack of teaching in Kitai is pertinent, not only because it makes Kitai unusable as a Section 102 reference, but also under Section 103 because it draws one of skill away from the asserted Kitai-Albright combination, as explained in the Appeal Briefs.

Examiner's response (B) argues that Kitai taken alone under Section 103 is grounds for rejecting claims 9 and 15, because private networks are not mentioned in those claims. But this argument fails to recognize that claims 9 and 15 include the limitations of their respective parent claims, which do expressly require private networks.

Examiner's response (C) misunderstands Appellants' argument. The Examiner treats the argument as one that states the combination fails to teach the claimed invention because Albright teaches serial networks rather than parallel networks. The response therefore understandably notes that the failure of one reference in a combination to teach a contested feature does not show that the combination as a whole fails to teach the feature, and thus to teach the invention. That is, the Examiner's answer is basically that it doesn't matter that Albright fails to teach parallel networks, because Kitai does teach parallel networks.

But this answer is directed at the wrong argument. Appellants are not arguing that Kitai combined with Albright fails to teach parallel networks. Rather, Appellants argue that Kitai and Albright were not properly combined.

Appellants' claims were improperly used as a blueprint. In the Office Action mailed 11/05/2003, the Examiner made rejections using Kitai as a Section 102 reference. In the next Response, Appellants pointed out that Kitai does not teach private networks, and hence cannot support rejections under Section 102. In the final action mailed 04/19/2004, the Examiner

asserted again that Kitai was a Section 102 reference. The Original Appeal Brief followed, in which pages 5 through 9 explained in detail and with supporting evidence why Kitai does not teach parallel networks and thus could not – by itself – support rejections. Instead of letting the appeal go to the Board, the Examiner then reopened prosecution. In the Reopening Office Action, the Examiner did *not* assert Kitai as a Section 102 reference. Instead, the Examiner made Section 103 rejections, supplementing Kitai by pointing to Albright for the necessary teaching of private networks. Of course, Albright cannot be used as a ground for rejection in combination with Kitai unless there is some suggestion or motivation in the art for combining those references. There is not.

Appellants argue that Albright and Kitai were not properly combined, not merely because the Examiner failed to give any specific evidence of a motivation or suggestion in the art supporting that combination, but also because of the undisputed fact that Albright deals with *serial* networks – a fact which would have led those of skill in the art away from combining Albright with Kitai when they were trying to build a *parallel* network configuration.

In short, Appellants argue against making the Kitai + Albright combination in the first place, not against the teachings of that (improper) combination once it is made. This argument has not been rebutted. The Kitai + Albright combination is improper, regardless of what it teaches or fails to teach.

Examiner's response (D) cites a portion of Pearce as a suggestion or motivation for adding Pearce to the Kitai + Albright combination. But this fails to support the rejection.

As noted in the Appeal Briefs, the underlying Kitai + Albright combination is not proper.

Moreover, the cited portion of Pearce does not point toward the teachings of Kitai or Albright as possible solutions to some problem. Indeed, even if one interprets Pearce as treating the need for a prioritized list of qualifying networks as a problem, one sees that Pearce promptly provides *its own solution* in the form of a filter 38. The undersigned did not find in Pearce any suggestion that a reader should look elsewhere for serial network-to-network interfaces as described in Albright, or for a LAN switch as described in Kitai. Pearce is self-contained in this respect, and thus would not have instilled a motive to look elsewhere to enhance or replace the filter 38. Accordingly, the combination of Pearce with Kitai and Albright is not proper.

Examiner's response (E) cites a portion of Dutta as a suggestion or motivation for adding Dutta to the Kitai + Albright combination. This fails to support the rejection.

As noted, the underlying Kitai + Albright combination is not proper.

Moreover, the cited portion of Dutta does not point toward the teachings of Kitai or Albright. As noted, e.g., on page 12 of the Original Appeal Brief, Dutta discusses firewalls and security while Kitai does not mention either. Albright discusses frame relay networks but Dutta does not. There is no evidence of any suggestion or motivation in Dutta that would have led one of skill to Kitai and Albright rather than somewhere else, and those of skill in the art did not have the claims to use as a blueprint. The combination of Dutta with Kitai and Albright is not proper.

Examiner's response (F) attempts to justify the even larger combination of Kitai, Albright, Pearce, and Dutta. As noted above and in the Appeal Briefs (which are incorporated as part of the record before the Board), the sub-combination of Kitai with Albright is not proper, and neither are the combinations of three references obtained by adding Pearce or Dutta alone to Kitai and Albright. The only basis for combining these four references is impermissible hindsight, which is driven by Appellants' claims, not by the prior art.

Examiner's response (G) fails to rebut the argument made at pages 12-13 of the Original Appeal Brief. Goldszmidt does not teach *sending* packets out of sequence as claimed. Rather, Goldszmidt views such non-sequential packets as an unfortunate problem and concerns itself with ways to handle *receiving* packets out of sequence. Nor is there a motivation for combining the references – as noted, Kitai fails to mention packet sequence, and the Kitai + Albright combination is not properly motivated.

Examiner's response (H) again tries to defend combining Kitai, Albright, and Dutta. As noted above, e.g., in regard to response (E), this combination is not proper.

Examiner's response (I) tries to defend combining Kitai, Pearce, and Goldszmidt. As noted above, e.g., in regard to responses (D) and (G), this combination is not proper.

Conclusion

Although this application was made special, examination has now stretched out to include *five* office actions, which contain substantial repetition:

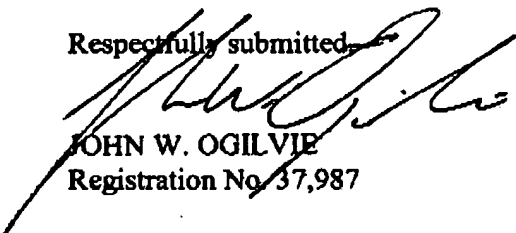
11/05/2003 citing Kitai, Pearce, Dutta, Goldszmidt, Albright
04/19/2004 citing Kitai, Pearce, Dutta, Goldszmidt, Albright
07/23/2004 citing Kitai
12/23/2004 citing Kitai, Pearce, Dutta, Goldszmidt, Albright
06/17/2005 citing Kitai, Pearce, Dutta, Goldszmidt, Albright

As a result, this application – which was granted accelerated examination status – is now entitled to a patent term adjustment of at least six months under 37 C.F.R. § 1.702(b). Further delay will further prejudice Appellants. All claims should be allowed, with the promptness required by the application's accelerated examination status. Barring that, the appeal should be promptly submitted to the Board for decision.

If any questions might be answered by telephone, the undersigned invites a call from the Office. Please note the new contact information shown below.

Dated this June 27, 2005.

Respectfully submitted,



JOHN W. OGILVIE
Registration No. 37,987

OGILVIE LAW FIRM
Customer No. 23484
1320 East Laird Avenue
Salt Lake City, UT 84105
801-706-2546 (voice)
801-583-0393 (fax)